

REMARKS

Reconsideration of this Application is respectfully requested.

Applicants note with thanks the Examiner's entry of the Amendment filed on August 3, 2004. Following entry of that Amendment, claims 9 and 12-16 are pending in the application. Applicants further note with thanks the Examiner's indication that claims 12-16 are allowable.

Claim Rejections

The Examiner has rejected claim 9 under 35 U.S.C. § 102 as anticipated by Hsiao, *et al.* Applicants respectfully traverse. For a reference to anticipate a claim, the reference must include, either expressly or inherently, all of the limitations of the claim. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), *quoted in* M.P.E.P. § 2131.

Hsiao does not report an invention identical to that of claim 9. Claim 9 claims, "An isolated *Corynebacterium* strain, wherein said strain produces at least about 10 g/l of L-lysine in 24 hours when grown in a bacterial culture medium containing at least about 1% raffinose."

Hsiao reports L-lysine production over time in Figure 1 and Figure 2. Figure 1 appears to report L-lysine production of 0 grams/liter at 0 hours, increasing to an amount greater than 10 g/l only after approximately 30 hours have elapsed. The production after about 24 hours appears to be far less than 10 g/l. Similarly, Figure 2 appears to report an even longer time, approximately 40 hours, for production to increase from 0 g/l to about 10 g/l. Neither Figure 1 nor Figure 2

reports a strain that produces at least about 10 g/l of L-lysine in 24 hours. The remainder of Hsiao similarly fails to report such a level of production in the given time period.

Hsiao does not contain at least one of the limitations present in claim 9. Applicants therefore respectfully submit that the rejection based on 35 U.S.C. § 102 has been traversed. They ask that the rejection be withdrawn and claim 9 allowed.

CONCLUSION

All of the stated grounds of rejection have been traversed. Applicants therefore respectfully request that the Examiner reconsider and withdraw the outstanding rejection and allow all pending claims. Applicants believe that a full and complete reply has been made to the outstanding Office Action and as such, the present Application is in condition for allowance. If the Examiner believes for any reason that personal communication will expedite prosecution of this Application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,



Dated: November 3, 2004

Duane A. Stewart III
Registration No. 54,468
BUCHANAN INGERSOLL PC
One Oxford Centre
301 Grant Street
Pittsburgh, Pennsylvania 15219
ph: (412) 562-1622
fx: (412) 562-1041